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09/666,655	09/20/2000	Mark E. Bloomfield	8798.00	5484

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EXAMINER

CHANG, JON CARLTON

ART UNIT	PAPER NUMBER
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2623

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DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/666,655

**Applicant(s)**

BLOOMFIELD, MARK E.

**Examiner**

Jon Chang

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,6,16-27,32 and 35-41 is/are rejected.
- 7) ☒ Claim(s) 2-5,7-15,28-31,33 and 34 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Response to Applicant's Amendment***

1. The amendment filed July 22, 2004, has been entered and made of record.

***Response to Applicant's Appeal Brief***

2. The Appeal Brief filed July 22, 2004, has been entered and made of record.

Applicant's arguments have been fully considered, and are persuasive as a whole. Therefore, the previous rejections relying on Browning (except for the rejection of claim 27) are withdrawn. Prosecution is hereby reopened.

The Examiner would like to make the following comments:

The Examiner now interprets subject matter of claims 2 and 28 to require that the type of address is discriminated, based on remarks made by Applicant in the Appeal Brief, in the paragraph bridging pages 17 and 18.

On page 23, last paragraph, Applicant states, "At the time when Browning displays the addresses, they are not stored. They are stored afterward." However, this does not appear to be supported by Browning. At column 4, lines 3-8, it seems that the addresses are stored, and then displayed.

With regard to Applicant's allegation, on page 29, that the Examiner did not provide rationale or evidence to show inherency, the Examiner responds by pointing out that he did provide rationale (see remarks for claim 2, on page 10. Almost the entire second paragraph provides the rationale). Whether or not the Applicant accepts this rationale is a different matter.

With regard to Applicant's question on page 39, next to last paragraph, "...what is the function set forth by the language 'command output means'," it is the Examiner's view that the function is a "command output". The label "command output" preceding "means" would seemingly imply more function than "means" alone.

With regard to Applicant's argument "POINT 1" on page 75, the Examiner agrees, the combination does not meet the invention as claimed. However, the Examiner notes that while a large part of Applicant's arguments throughout the Appeal Brief relate to how the prior art relied upon by the Examiner does not disclose or suggest the invention **as claimed**, Applicant dismisses the Examiner's statement in the Final Office Action that Applicant was arguing features which were not specifically claimed. Respectfully, as the Examiner is expected to address the language of the claims (as Applicant apparently agrees, based on arguments presented in the Brief), when discussing claims, the Examiner would logically try to relate specific arguments to the language in the claims.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 25-27, 32 and 37-39 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,905,251 to Knowles.

As to claim 1, Knowles discloses a hand-held control device for controlling a terminal connectable by a communications network to an addressed resource (column 11-16), the device comprising:

address input means for scanning a text address of the resource (Fig.3; column 8, lines 35-47; column 9, lines 17-27; note that the bar code scanner in the second embodiment can be replaced with an optical character reader as per the third embodiment); and

command output means for uploading address information from the device to the terminal and causing the terminal to connect to the addressed resource (column 9, lines 23-27; since the scanner and the terminal are integrated into the same unit, the address information is inherently uploaded to the terminal).

As to claim 25, Knowles discloses a system comprising:

a hand-held control device (Fig.3) for controlling a terminal connectable by a communications network to an addressed resource, the device including (i) address input means for scanning a text address of the resource (column 9, lines 17-27), and (ii) command output means for uploading address information from the device to the terminal and causing the terminal to connect to the addressed resource (column 9, lines 23-27); and

a terminal for downloading address information from the device (column 8, lines 40-50).

As to claim 26, Knowles discloses a system according to claim 25, wherein the terminal includes means for recognizing, verifying and acting upon command data (column 8, lines 35-47; column 9, lines 18-32; it is understood that the character reader recognizes and verifies, as part of character reading, and the device acts on the command data in order to access the desired web site).

As for claims 27, 32 and 37, the remarks provided above for claims 1 and 26 are applicable.

Regarding claim 38, Knowles discloses the method according to claim 37, wherein the addressed resource is an Internet resource and the terminal launches a browser and uses that browser to load the Internet Resource (column 9, lines 23-27).

Regarding claim 39, Knowles discloses the method according to claim 38, further comprising displaying, viewing and optionally interacting with the Internet resource (column 1, lines 33-37; column 3, lines 11-17; column 9, lines 17-27).

5. Claims 1, 2, 20-21, 25, 26, 27, 32, 35 and 37-39 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication 20030093384 to Durst, Jr. et al. (hereinafter "Durst").

As to claim 1, Durst discloses a hand-held control device for controlling a terminal connectable by a communications network to an addressed resource (Fig.2A; paragraphs [0010] and [0078]), the device comprising:

address input means for scanning a text address of the resource (Fig.2A; paragraph [0078]); and

command output means for uploading address information from the device to the terminal and causing the terminal to connect to the addressed resource (paragraphs [0050] [0078], [0079]).

With regard to claim 6, Durst discloses the according to claim 1, further comprising control means responsive to the orientation and/or movement of the device (paragraph [0079]; note that passing the scanning system over the document is a movement, and responsive to this, the device transmits information to the terminal to access online resources.).

Referring to claim 20, Durst discloses a device according to claim 1, wherein the command output means uploads information to the terminal by wireless transmission (paragraphs [0081]-[0082]).

Regarding claim 21, Durst discloses a device according to claim 20, wherein the command output means includes an IR or RF transmitter (paragraph [0082]; Fig.2B).

As to claim 25, Durst discloses a system comprising:

a hand-held control device (Fig.2A; paragraphs [0010] and [0078]) for controlling a terminal connectable by a communications network to an addressed resource, the device including (i) address input means for scanning a text address of the resource (Fig.2A), and (ii) command output means for uploading address information from the device to the terminal and causing the terminal to connect to the addressed resource (paragraphs [0050] [0078], [0079]); and

a terminal for downloading address information from the device (paragraph [0081]).

As to claim 26, Durst discloses a system according to claim 25, wherein the terminal includes means for recognizing, verifying and acting upon command data (paragraphs [0078]-[0079]).

As for claims 27, 32 and 37, the remarks provided above for claims 1 and 26 are applicable.

As for claim 35, Durst discloses a method according to claim 27, further comprising uploading information to the terminal by wireless transmission (paragraph [0082])

Regarding claim 38, Durst discloses the method according to claim 37, wherein the addressed resource is an Internet resource and the terminal launches a browser and uses that browser to load the Internet Resource (paragraphs [0050] and [0105]).

Regarding claim 39, Durst discloses the method according to claim 38, further comprising displaying, viewing and optionally interacting with the Internet resource (paragraphs [0106]-[0110]).

6. Claims 23, 24 and 40-41 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,456,749 to Kasabach et al. (hereinafter "Kasabach").

As to claim 23, Kasabach discloses a hand-held control device for controlling a terminal, the device comprising:

command output means for uploading a text or graphics file from the device to



the terminal (column 2, lines 1-3; column 5, lines 35-38; column 8, lines 8-10);

sensor means for sensing movement of the device when the device is used as a writing or drawing instrument (column 4, lines 58-65); and

means for generating the text or graphics file as a user writes or draws with the device (column 5, lines 35-38; column 8, lines 8-10).

Regarding claim 24, Kasabach discloses a device according to claim 23, connectable by a communications network to an addressed resource (column 5, lines 40-51), wherein the command output means includes means for causing the terminal to connect by a communications network to an addressed resource and to convey the text or graphics file as message information to that resource (column 7, lines 1-7).

Regarding claims 40 and 41, see the remarks provided above for claims 23 and 24.

7. Claim 27 is rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,081,629 to Browning.

As to claim 27, Browning discloses a method of controlling a terminal ("terminal" is interpreted in the broad sense. The personal computer or the network computer, column 3, lines 31-32, are considered terminals) connectable by a communications network to an addressed resource (column 2, lines 15-16), the method comprising:

scanning a text address of the resource (column 2, lines 29-32; column 2, lines 42-45); and

uploading address information from the device to the terminal and causing the terminal to connect to the addressed resource (column 3, lines 26-28; column 3, lines 36-44).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 18-19, 22 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Knowles and Browning.

As to claim 18, Knowles does not disclose that the device further comprises means for storing a plurality of resource addresses. However, this is well known in the art as evidenced by Browning (column 4, lines 3-4). This provides inherent advantages, such as allowing sorting (Browning, column 4, lines 5-14), or allowing multiple addresses to be scanned, while holding the addresses until the user is ready to visit the corresponding websites. Therefore, it would have been obvious to one of ordinary skill in the art to modify Knowles according to Browning.

Regarding claim 19, Knowles does not disclose the recited limitations. However, Browning discloses (i) means for displaying all of the stored resource addresses (column 2, lines 58-60), and (ii) means for selecting an appropriate one of the stored and displayed resource addresses (column 4, lines 29-30). This provides inherent

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advantages, such as allowing the user to choose a website as desired. Therefore, it would have been obvious to one of ordinary skill in the art to modify Knowles according to Browning.

As to claims 22 and 36, Knowles does not disclose that the device further comprises display means for providing a confirmatory display of a scanned address (Knowles discloses a display means, but there is no description of providing a confirmatory display of the address). However, this is well known as evidenced by Browning (column 2, lines 58-62). This provides the advantage of allowing the user to verify that the address has been correctly scanned and recognized. Therefore, it would have been obvious to one of ordinary skill in the art to modify Knowles according to Browning.

10. Claims 18-19, 22 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Durst and Browning.

As to claim 18, Durst does not disclose that the device further comprises means for storing a plurality of resource addresses. However, this is well known in the art as evidenced by Browning (column 4, lines 3-4). This provides inherent advantages, such as allowing sorting (Browning, column 4, lines 5-14), or allowing multiple addresses to be scanned, while holding the addresses until the user is ready to visit the corresponding websites. Therefore, it would have been obvious to one of ordinary skill in the art to modify Durst according to Browning.

Regarding claim 19, Durst does not disclose the recited limitations. However, Browning discloses (i) means for displaying all of the stored resource addresses (column 2, lines 58-60), and (ii) means for selecting an appropriate one of the stored and displayed resource addresses (column 4, lines 29-30). This provides inherent advantages, such as allowing the user to choose a website as desired. Therefore, it would have been obvious to one of ordinary skill in the art to modify Durst according to Browning.

As to claims 22 and 36, Durst does not disclose that the device further comprises display means for providing a confirmatory display of a scanned address. However, this is well known as evidenced by Browning (column 2, lines 58-62). This provides the advantage of allowing the user to verify that the address has been correctly scanned and recognized. Therefore, it would have been obvious to one of ordinary skill in the art to modify Durst according to Browning.

11. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Knowles and U.S. Patent 5,574,804 to Olschafskie et al. (hereinafter "Olschafskie").

Regarding claim 16, Knowles does not disclose that the device further comprises a head end and an elongate barrel terminating distally in the head end to provide a generally pen-like size and shape. However, this is well known as evidenced by Olschafskie (Figs. 2; 5 and 6). Olschafskie discloses a scanner for optical character recognition. Knowles requires the use of a scanner, and suggests the use of pen type

devices (column 8, line 62). Olschafskie's scanner would allow more convenient use of the device, as it would allow holding of the device like a pen (Fig.1). Therefore, it would have been obvious to one of ordinary skill in the art to modify Knowles according to Olschafskie.

With regard to claim 17, Knowles discloses that the address input means includes a scanner (column 8, lines 35-37), but does not disclose that the head end defines a surface that is obliquely angled to the longitudinal axis of the barrel such that the surface including the scanner is presented flat to a surface containing an item to be scanned. However, this is well known as evidenced by Olschafskie (Figs.1, 5 and 6). Olschafskie discloses a scanner for optical character recognition. Knowles requires the use of a scanner, and suggests the use of pen type devices (column 8, line 62). Olschafskie's scanner would allow more convenient use of the device, as it would allow holding of the device like a pen (Fig.1). Therefore, it would have been obvious to one of ordinary skill in the art to modify Knowles according to Olschafskie.

12. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Durst and U.S. Patent 5,574,804 to Olschafskie et al. (hereinafter "Olschafskie").

Regarding claim 16, Durst does not disclose that the device further comprises a head end and an elongate barrel terminating distally in the head end to provide a generally pen-like size and shape. However, this is well known as evidenced by Olschafskie (Figs. 2; 5 and 6). Olschafskie discloses a scanner for optical character

recognition. Durst requires the use of a scanner (paragraph [0078]). Olschafskie's scanner would allow more convenient use of the device, as it would allow holding of the device like a pen (Fig.1). Therefore, it would have been obvious to one of ordinary skill in the art to modify Durst according to Olschafskie.

With regard to claim 17, Durst discloses that the address input means includes a scanner (paragraph [0078]), but does not disclose that the head end defines a surface that is obliquely angled to the longitudinal axis of the barrel such that the surface including the scanner is presented flat to a surface containing an item to be scanned. However, this is well known as evidenced by Olschafskie (Figs.1, 5 and 6). Olschafskie discloses a scanner for optical character recognition. Durst requires the use of a scanner (paragraph [0078]). Olschafskie's scanner would allow more convenient use of the device, as it would allow holding of the device like a pen (Fig.1). Therefore, it would have been obvious to one of ordinary skill in the art to modify Durst according to Olschafskie.

#### ***Allowable Subject Matter***

13. Claims 2-5, 7-15, 28-31 and 33-34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***References Cited***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 6,321,991 to Knowles is cited because its disclosure is similar to that of U.S. patent 5,905,251.

Published Japanese Patent Application 11-177752 to Nishibayashi teaches scanned data is transmitted to an electronic mail server if an email address is designated.

Published Japanese Patent Application 10-75290 to Abura et al. teaches a scanner reading a telephone number on a document, and automatic dialing of the telephone number.

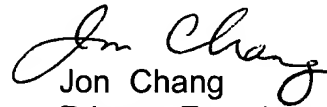
***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon Chang whose telephone number is (703)305-8439. The examiner can normally be reached on M-F 8:00 a.m.-6:00 p.m..

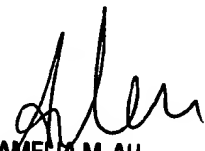
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on (703)308-6604. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Jon Chang  
Primary Examiner  
Art Unit 2623

Jon Chang  
October 18, 2004

  
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